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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,784	11/07/2001	Michiko Fukuda	15056	7912
23389	7590	07/22/2004	EXAMINER	
SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA GARDEN CITY, NY 11530			ENG, GEORGE	
			ART UNIT	PAPER NUMBER
			2643	19

DATE MAILED: 07/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/043,784

**Applicant(s)**

FUKUDA, MICHIKO

**Examiner**

George Eng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/28/2004 (paper no. 17) has been entered.

### ***Response to Amendment***

2. This Office action is in response to the amendment filed 5/28/2004 (paper no. 18).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 5-10 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kadowaki et al. (US PAT. 5,414,457) in view of Uchimi et al. (US PAT. 6,078,721 hereinafter Uchimi).

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Regarding claim 1, Kadowaki discloses a telephone unit as shown in figure 4 having a telephone directory with picture data comprising video interface (10, figure 3) for receiving compressed image data from a distant station (col. 3 lines 34-35), decoding means (20) for decoding the received compressed image data into an image signal (col. 3 lines 31-32), correlating means (50, figure 3) for correlating the image signal with a telephone number of the distant station (col. 4 lines 4-6), and registering means (41, figure 1) for registering the image signal and the telephone number with the telephone directory (col. 4 line 48 through col. 6 line 17). Kadowaki differs from the claimed invention in not specifically teaching receiving compressed moving picture data from the distance party so that first decode means decodes the compressed moving picture data and encoding means encodes one or more frames of the decoded moving picture data into compressed still picture data in order to register, wherein the still picture data generated by said encoding means is in conformity with a still picture format which is different from a moving picture format with which the moving picture data is in conformity. However, Uchimi teaches a device capable of storing moving picture data received from a communication party comprising video restoring portion/decoding portion for decoding the compressed moving picture data, and still-picture coding portion for encoding one or more frames of the decoded moving picture data into a compressed still picture data, wherein the still picture data generated by the still-picture coding portion is in conformity with a still picture format which is different from a moving picture format with which the moving picture data is in conformity in order to make comply with various kinds of coded format (col. 4 lines 3-12, col. 8 lines 6-65 and col. 9 lines 8-35). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Kadowaki in receiving compressed

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moving picture data from the distance party so that first decode means decodes the compressed moving picture data and encoding means encodes one or more frames of the decoded moving picture data into compressed still picture data in order to register, wherein the still picture data generated by said encoding means is in conformity with a still picture format which is different from a moving picture format with which the moving picture data is in conformity, as per teaching of Uchimia, because it make possible to comply with various kinds of coded format.

Regarding claim 2, Kadowaki discloses to correlate the compressed still picture data with personal information of the distant station, wherein the personal information includes the telephone number of the distant station (col. 4 lines 60-64).

Regarding claim 5, Uchimi discloses to reproduce, i.e., display, the decoded moving picture, and selecting means for selecting the one or more frames to be encoded by the encoding means in response to an operation by a user (col. 6 lines 44-65)

Regarding claim 6, Kadowaki discloses second display means as shown in figure 2 for displaying the decoded still image data decoded by decoding means (col. 6 lines 15-34 and col. 5 line 9-38).

Regarding claim 7, Kadowaki teaches to display the decoded still picture when originating a call to the distant station (col. 5 lines 9-23).

Regarding claim 8, Uchimi teaches to restore the decoded still picture for reproducing after communication ends (col. 9 lines 8-42).

Regarding claim 9, the limitations of the claim are rejected as the same reasons set forth in claim 1.

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Regarding claim 10, the limitations of the claim are rejected as the same reasons set forth in claim 2.

Regarding claim 13, the limitations of the claim are rejected as the same reasons set forth in claim 5.

Regarding claim 14, the limitations of the claim are rejected as the same reasons set forth in claim 6.

Regarding claim 15, the limitations of the claim are rejected as the same reasons set forth in claim 7.

Regarding claim 16, the limitations of the claim are rejected as the same reasons set forth in claim 8.

5. Claims 3-4 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kadowaki et al. (US PAT. 5,414,457) in view of Uchimi et al. (US PAT. 6,078,721 hereinafter Uchimi) as applied in claims above, and further in view of Kimura et al. (US PAT. 5,778,054 hereinafter Kimura).

Regarding claim 3, the combination of Kadowaki and Uchimi differs from the claimed invention in not specifically teaching to register the compressed still picture and the telephone number with the telephone directory in JPEG format in which the telephone number is being recorded in a comment segment of a JPEG file. However, Kimura teaches a storage device storing access information, i.e., telephone numbers, corresponding to image information, wherein the access information and the image information are registered in JPEG format so that it recognizes the access information being recorded in a comment segment of a JPEG file in order

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to simplify physical structure and intuitive graphical user interface (col. 4 line 29 through col. 6 line 10). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Kadowaki and Uchimi in registering the compressed still picture and the telephone number with the telephone directory in JPEG format in which the telephone number is being recorded in a comment segment of a JPEG file, as per teaching of Kimura, because it simplifies physical structure and intuitive graphical user interface.

Regarding claims 4, 11 and 12, the limitations of the claims are rejected as the same reasons set forth in claim 3.

#### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shibata et al. (US PAT. 5,936,945) discloses a teleconferencing terminal equipment a picture codec for delivering the digitized picture data to either the video coder or still picture coder under the control of the peripheral device control interface (col. 7 line 47 through col.9 line 10). Maeda (US PAT. 5,353,062) discloses a method for displaying high quality still images in which motion compensation by inter-frame prediction is performed on supplied moving image data (abstract). Yamada (JP 05007356A) discloses a image reproducing device to convert an encoded moving image into a still image data so as to edit reproduce and record in common

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medium (abstract). Kato et al. (JP 04341087A) discloses a picture information device to enable mutual communications of picture information between a moving picture video telephone set dealing with a moving picture and a still picture video telephone set dealing with still picture (abstract). Oki et al. (JP 03009685A) discloses a picture encoder to widely enlarge the limit of communication by encoding an input picture signal by using correlation in a picture and correlation between pictures and outputting a moving image output signal and a still picture signal (abstract).

8. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

Or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, V.A., Sixth Floor (Receptionist).


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is 703-308-9555. The examiner can normally be reached on Tuesday to Friday from 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A. Kuntz, can be reached on (703) 305-4870. The fax phone number for the organization where this application or proceeding is assigned is 703-308-6306.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

A handwritten signature in black ink, appearing to read "George Eng". The signature is fluid and cursive, with the first name "George" written in a larger, more prominent script than the last name "Eng".

George Eng  
Examiner  
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